



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,186	03/19/2004	Werner Doetsch	038715.53337US	6767

23911 7590 10/30/2006

CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

EXAMINER

CHORBAJI, MONZER R

ART UNIT	PAPER NUMBER
----------	--------------

1744

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/804,186

Applicant(s)

DOETSCH ET AL.

Examiner

MONZER R. CHORBAJI

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/19/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This general action is in response to the application filing date of 03/19/2004

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Grimberg et al (U.S.P.N. 5,609,821).

Regarding claim 1, Grimberg teaches a stabilized hydrogen peroxide composition (col.2, lines 29-30) that includes an intimate mixture of hydrogen peroxide (col.3, lines 33-38) with from less than 50 mg/Kg of a foodstuff-compatible phosphonic acid (col.3, lines 14-16).

Regarding claim 3, Grimberg teaches the use of aminotrismethylene phosphonic acid (col.3, lines 14-16).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimberg et al (U.S.P.N. 5,609,821).

Regarding claim 4, Grimberg discloses a method for sterilizing foodstuff-packaging material (col.2, lines 15-20 and col.4, lines 3-5) that includes contacting the packaging material with a liquid mixture of stabilized hydrogen peroxide (col.2, lines 29-30 and col.3, lines 33-38) with foodstuff-compatible phosphonic acid (col.3, lines 14-16). Grimberg teaches that in the art of sterilizing packaging material, liquid hydrogen peroxide can either be sprayed on such material or the material is soaked in a bath

containing liquid hydrogen peroxide (col.1, lines 19-30). Therefore, absent any criticality, choosing either one of the hydrogen peroxide sterilization approach is a matter of routine experimentation depending on the degree of contamination of the packaging material so that for heavily contaminated packaging material one would choose the spraying approach and for not so contaminated material one would choose soaking it in a hydrogen peroxide bath (col.1, lines 28-30).

Regarding claims 5 and 7, Grimberg teaches that the concentration of the foodstuff-compatible phosphonic acid is from less than 50 mg/Kg (col.3, lines 14-16) and the use of aminotris(methylene) phosphonic acid (col.3, lines 14-16).

7. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimberg et al (U.S.P.N. 5,609,821) as applied to claims 1, 5 and further in view of Feasey et al (U.S.P.N. 5,130,053).

Regarding claims 2 and 6, Grimberg fails to teach concentration ranges between 200 to 500 ppm of phosphonic acid. Feasey discloses a composition of hydrogen peroxide and phosphonic acid and teaches that the concentration of phosphonic acid varies between 50 to 1000 ppm depending on intended use (col.4, lines 40-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to widen Grimberg concentration range of phosphonic acid to a different concentration range as taught by Feasey since in the art of sterilizing objects, the concentration range of between 50 to 1000 ppm for phosphonic acid is found to be the most effective (Feasey, col.7, example 5).

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grimberg et al (U.S.P.N. 5,609,821) as applied to claim 4 and further in view of Vogele et al (U.S.P.N. 4,104,024).

Grimberg teaches that it is known to apply hot liquid hydrogen peroxide to packaging materials (col.1, lines 24-27). However, Grimberg fails to explicitly teach temperature value for the hydrogen peroxide bath. Vogele disclose that it is known to heat hydrogen peroxide baths to a temperature of 90 degrees Celsius (col., lines 10-21). Vogele also teaches that maintaining temperature of about 90 degrees Celsius is complex and expensive as well. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Grimberg hydrogen peroxide bath temperature to a temperature below 90 degrees Celsius as taught by Vogele since in this temperature range all bacteria spores are destroyed (Vogele, col.1, lines 15-23).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Irani (U.S.P.N. 3,234,140), Carnine (U.S.P.N. 3,383,174) and Winkley (U.S.P.N. 3,903,244) all disclose stabilized hydrogen peroxide composition in an intimate admixture with phosphonic acids.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONZER R. CHORBAJI whose telephone number is (571) 272-1271. The examiner can normally be reached on M-F 9:00-5:30.

Art Unit: 1744

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, GLADYS J. CORCORAN can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MRC


GLADYS J. CORCORAN
SUPERVISORY PATENT EXAMINER